

REMARKS

In the outstanding Office Action, the Examiner rejected claims 1-18. Claims 1-18 are pending and under consideration. Applicant appreciates the Examiner taking the time to conduct a telephone interview on September 17, 2003, to allow Applicant to better reflect Applicant's understanding of the invention as claimed. Applicant further appreciates the Examiner's willingness to reconsider the invention as recited by the claims in this amendment after final.

Telephone Interview:

Applicant and the Examiner conducted a telephone interview on September 17, 2003, to better reflect both parties' understanding of the invention, as claimed, and of the references previously cited. In particular, as recited by the claims as amended on March 24, 2003, the clamping aspect of Applicant's invention includes two separate steps. First, the tab is rotated into position by the turning action caused by the user twisting the screw. Second, after the tab rotates into place, it is prevented from further rotating and therefore subsequent twisting of the screw by the user draws the tab further against the panel, creating a more secure clamp.

The parties discussed claim 1 and four references, namely: U.S. Pat. No. 5,311,397 to Harshberger et al., ("Harshberger"), U.S. Pat. No. 4,856,295 to Bolton et al., ("Bolton"), U.S. Pat. No. 5,887,916 to Finkelstein et al., ("Finkelstein"), and U.S. Pat. No. 5,630,632 to Swan, ("Swan"). Although the Examiner and Applicant did not conclude as to a proper amendment to the claims, the Examiner indicated that he was willing to consider this response in light of the discussions undertaken in the interview.

Rejection Under 35 U.S.C. § 103(a):

The Examiner rejected claims 1-18 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Pat. No. 5,311,397 to Harshberger et al., ("Harshberger") in view of U.S. Pat. No. 4,856,295 to Bolton et al., ("Bolton") and further in view of U.S. Pat. No. 5,887,916 to Finkelstein et al., ("Finkelstein"). Office Action at pages 2 to 3.

As was discussed in the interview, Applicant believes that none of the references teaches the claimed invention because no reference teaches two separate steps when clamping a device. Specifically, claim 1, as amended, recites, in part:

“A panel mountable electronic device...comprising...a tab with a threaded hole...a screw...wherein said screw may be...engaged in said threaded hole such that a rotation of said screw rotates said tab into position to clamp a portion of said panel between said tab and said flange, and wherein further rotation of said screw forcibly clamps a portion of said panel between said tab and said flange.”

As stated above, Applicant's invention, as claimed, recites a clamping aspect including the two separate steps of rotating a tab into position and further providing a more secure clamping action by drawing the tab against the panel with further twisting of the screw.

The law provides a standard for obviousness with respect to patentable inventions, namely the cited references must state a motivation to combine them to obtain the proposed invention, as claimed. (See generally, “[t]he mere fact that references can be modified or combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). Applicant respectfully asserts that none of the cited references provide a motivation to combine to provide both steps discussed above of the present invention, as recited by the claims. Further, Applicant respectfully submits that the cited references do not suggest the present invention as recited by the claims without using an impermissible hindsight reconstruction of Applicant's invention. With respect to these arguments regarding the Harshberger, Bolton, and Finkelstein references, Applicant respectfully refers to the immediately preceding office action response, dated July 24, 2003.

Swan teaches a quarter turn latch that secures a panel (“100”, Fig. 1). Referring to Fig. 1 of Swan, the latch 10 consists of an actuating member 14 that fits through a mounting surface 100 to interface with a latching member 12. However, Swan's latch secures the panel by twisting actuating member 14 through a quarter-turn (i.e., a 90-degree turn). This quarter-turn moves actuating member 14 within latching member 12 to form a mechanical interlock (see Figs. 3-4). Swan does not teach further twisting of

actuating member 14 once it is twisted through a quarter-turn. Indeed, suggesting that Swan teaches rotation further than 90 degrees would defeat its teachings because after 90 degrees of motion, several components of the Swan invention prevent further rotation of actuating member 14 in the same direction. See col. 4, lines 32-39 and lines 43-49. Thus, it is impossible for Swan to teach that further rotation of actuating member 14 would provide a further clamping action, as is recited by claim 1 of the present invention. For the same reasons, nowhere does Swan suggest a motivation to combine its teachings with a further rotation of actuating member 14 to provide a further clamping action, as is recited by claim 1 of the present invention.

The present invention does involve simple technology. However, rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references “is *especially important in the case of less technologically complex inventions*, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), *abrogated on other grounds* (citations omitted) (emphasis added).

For at least the reasons discussed above, Applicant respectfully submits that claim 1 is patentable over the Harshberger-Bolton-Finkelstein combination. Claims 2-10 all depend from claim 1. Thus, these claims are allowable for at least the same reasons discussed above for claim 1.

The arguments above relating to claim 1 apply equally to claim 11. For example, claim 11, as amended, recites, in part, “continuing rotation of said screw to forcibly clamp said portion of said panel between said tab and said flange.” Thus, for at least these reasons, Applicant respectfully submits that claim 11 is patentable over the Harshberger-Bolton-Finkelstein combination.

Claims 12-18 all depend from claim 11. Thus, these claims are allowable for at least the same reasons discussed above for claim 11.

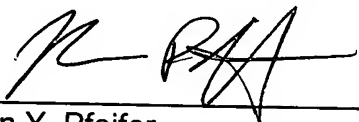
In view of the foregoing arguments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 14, 2003

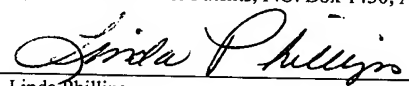
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